

REMARKS

Claims 1 through 20 were originally presented for examination. In a Restriction Requirement by the Examiner, made telephonically, the claims were restricted into two groups, the first being to those claims covering a trapezoidal base, and the second being to those claims having a bottom with parallel sides. The undersigned elected group I, without traverse. Applicant confirmed that election without traverse. Further, applicant agreed with the Examiner's selection of claims that were examined.

In the Office Action of May 16, 2003, claims 1 through 10 were examined, and claims 11 through 20 were withdrawn from consideration. An Amendment and Response (corrected) was filed on October 14, 2003 wherein all of the nonelected claims were cancelled, all of the rejected claims were cancelled, and new claims 21 through 28 were presented.

In the Christmas Eve Office Action of December 24, 2003, the Examiner rejected all of the new claims 21 through 28 based either on 35 USC 102(b) or 35 USC 103(a) based on the Zibell patent. This was a Final Rejection. In that Office Action, the drawings that had been submitted on September 12, 2003 were indicated as accepted.

In response to the Final Rejection of all pending claims, Applicant appealed. Proper Notice of Appeal was filed, as was an Appeal Brief. The Appeal Brief was filed on April 23, 2004.

Apparently after review and supervisor consultation, instead of filing an Answer, the Examiner sent an Office Action on June 14, 2004 wherein it was stated that "in view

if the Appeal Brief filed on 4/23/04, Prosecution is hereby reopened. New grounds of rejection are set forth below.” Hence, the Patent Office conceded on the Appeal, and found yet new grounds for rejection in the June 14, 2004 Office Action. This instant filing is in response to this latest round of rejections.

First, Figure 5, element 1, is objected to for alleged improper hatching. In response, applicant wishes to point out that there is no hatching in Figure 5, nor is there an element 1 in Figure 5. Further, these drawings were accepted by the Office Action of December 23, 2003. Clarification of the objection or withdrawal thereof is respectfully requested.

Second, the claims have been rejected (nonfinal), on the following bases:

Claim 21 rejected under 35 USC 102(b) on Zibell.

Claim 21 rejected under 35 USC 102(b) on Fisher et al.

Claims 21 and 23 rejected under 35 USC 102(e) on GB 1,350,754.

Claims 24 and 26 through 28 rejected under 35 USC 102(e) on Chen.

Claim 22 rejected under 35 USC 103(a) over Fisher et al in view of Naccarato et al.

Claim 23 rejected under 35 USC 103(a) over Zibell.

Claim 24 rejected under 35 USC 103(a) over Major in view of Fisher et al.

Claim 25 rejected under 35 USC 103(a) over Major in view of Fisher et al and further in view of Naccarato et al.

Applicant responds as follows:

I. Claim 21 Rejected under 35 USC 102(b) based on Zibell

Claim 21 stands rejected under 35 USC 102(b) as being anticipated by Zibell. Contrary to the Examiner's interpretation of Zibell, this reference does not teach a trapezoidal shaped bottom as set forth in claim 21 and the new claims. There are two separate reasons why Zibell is not appropriate to be cited against claim 21 or the new claims set forth herein. First, the section of Figure 11 of the reference copied by the Examiner in the Office Action and marked as A-9 is not a trapezoid, nor does it have a trapezoidal shape. It is an irregular pentagon or hexagon. It clearly has five sides plus its top connection. Second, the section marked as A-9 is not even a bottom. It is located between the top and the bottom, about $\frac{3}{4}$ of the distance down from the top. Hence it is a middle section of the prior art device. This can be seen in both Figures 9 and 11 of Zibell. Third, the Zibell component relied upon by the Examiner does not even have a flat bottom, as the bottom is tapered upwardly from the center of the bottom (like an inverted pentagonal house!). A flat bottom is a material limitation that has been ignored or overlooked repeatedly with the use of the Zibell reference.

In addition to the foregoing arguments, all of the arguments pertaining to Zibell in the appeal Brief and the prior Office Action Responses are repeated here and incorporated herein by reference and preserved for purposes of appeal.

Further, all of the new claims specifically recite that the anchoring device is "consisting essentially of" the recited elements. Clearly Zibell has essential elements not in the present invention device, to wit, plural center post sections

including component 78 of Figure 11 of Zibell, and the non-flat bottom of Zibell below the post section 78 of that Figure. Since all of the claims state that the device consists essentially of the elements set forth in the claims, the rejection should be withdrawn.

II. Claim 21 Rejected under 35 USC 102(b) based on Fisher et al

The reference to Fisher et al specifically recites an invention totally unrelated to the present invention and the rejection based on this reference should be withdrawn. First, it is nonanalogous art. One of ordinary skill in the field of wood and simulated wood decks would not look to the steel beam areas of concrete and steel building construction. Second, the device relied upon by the Examiner is a steel dissymmetric beam for horizontal insertion between other steel beams, with concrete or other grouting is interspersed for its formation. Thus, there is not any teaching of a device as claimed. Third, the present invention consists essentially of a plastic molded item, as a fastener must be easily passed through it to anchor it to a joist, whereas the Fisher et al reference is directed to an opposite purpose, namely keep the integrity of the device and embed it in concrete or other hardener to support the structures taught therein. Further, the Fisher et al device must be made of steel or it will fail. It is specifically taught to be steel and no doubt would fail if it were anything less. Thus, Fisher uses a different device for a different purpose with a different result, and the rejection should be withdrawn.

III. Claims 21 and 23 Rejected under 35 USC 102(e) on GB1,350,754

The British Patent 1,350,754 (hereinafter “GBP”) teaches joint seal strips for roofing that has a bottom that is wider than its top, the exact opposite of the present invention as claimed, and the strip does not consist essentially of a bottom element having two sides with a flat bottom and sides with a trapezoidal shape. In fact, the GBP has a plurality of spikes on its bottom for creating channels to control rain runoff. These are essential elements of the GBP device and are not claimed in the present invention. For all of these reasons this rejection should be withdrawn.

IV. Claims 24 and 26-28 rejected under 35 USC 102(e) on Chen

First, the Chen reference describes a tiling system with splines, and illustrates splines that have two components. Even if these splines are inverted, as implied by the Examiner’s discussion, but not shown as such in the illustration, the result is completely opposite the claimed present invention anchor. Critically, the present invention device has a widest top, a narrowest middle and a bottom in between. The Chen item is not an anchoring device, does not connect two adjacent boards and a joist, and has a middle that is widest instead of narrowest! Further, its top is not widest. Merely picking a middle section and calling it a top does not make it so. Further, the Chen reference does not have a bottom with the

claimed shape set forth in the present invention claims. Its top has some relative shape, but lacks the dimensional relationships claimed in the present invention. There are no trapezoidal walls and bottom to its bottom element as in the present invention. Third, whether upside down or inverted, it does not have a middle section between the top and the bottom that consists essentially of a width that is less than the widths of both the top and bottom, as claimed herein. This reference is totally lacking in any similarity with the claimed invention. For these reasons, the Chen reference rejection should be withdrawn.

V. Claim 22 Rejected under 35 USC 103(a) over Fisher et al in view of Naccarato et al.

The rejection based on these two references has all of the deficiencies as to Fisher et al as set forth above in Section II, and these arguments are here repeated and incorporated herein by reference and preserved for purposes of appeal. The secondary reference to Naccarato et al does not teach that deck anchoring devices should have recesses with columns and its fastener is a teaching away from the present invention device as it lacks all of the shape elements of which the present invention essentially consists. Further, even if Naccarato et al taught everything that the Examiner asserts, it still would not overcome the shortcomings of the Fisher et al patent. For all of these reasons, this rejection should be withdrawn.

VI. Claim 23 rejected under 35 USC 103(a) over Zibell

All of the comments and arguments above as to Zibell and as to Zibell in the appeal Brief and the prior Office Action Responses are repeated here and incorporated herein by reference and preserved for purposes of appeal. Further, it would not be obvious to use plastic in the Zibell device on the basis that it is known that plastic is capable of having a metal fastener driven through it because Zibell never uses a metal fastener on the piece relied upon by the Examiner. For all of these reasons, this rejection should be withdrawn.

VII. Claim 24 rejected under 35 USC 103(a) over Major in view of Fisher et al.

The reference to Major describes a connecting element that does not involve a support board (joist), and that element neither has a trapezoidal section, nor does it have a single width section relationship as set forth in all of the claims. The secondary reference to Fisher et al is lacking to overcome the deficiencies for all of the reasons discussed above herein relating to that reference, and which arguments are repeated here, incorporated by reference herein, and preserved for purposes of appeal.

**VIII. Claim 25 Rejected under 35 USC 103(a) over Major in view of
Fisher et al and further in view of Naccarato et al**

All of the primary reference to Major, and the secondary reference to Fisher et al, comments, deficiencies, and arguments discussed everywhere above relating to those references in combination and separately, are repeated here, and incorporated by reference herein, and preserved for purposes of appeal. Likewise, all of the comments, deficiencies and arguments to Naccarato et al are repeated here, incorporated by reference herein, and preserved for purposes of appeal. The secondary reference does not overcome the shortcomings of the primary reference, and the tertiary reference does not overcome the shortcomings of the primary and secondary references. Further, their combination is not possible because of the conflicting physical arrangements of each, because they are nonanalogous, and because there is no motivation to combine them. Further, if the combination is possible, the results are different from the present invention and lack the essential elements of which the present invention consists.

IX. Conclusions

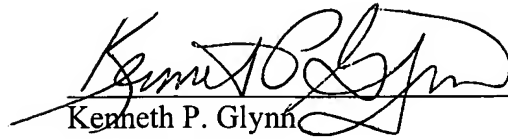
A Petition with fees are included herewith for the late filing.

For all of the above reasons, it is urged that the newly presented claims 29 through 38 are neither taught nor obvious over the cited references, and should be allowed. An early and favorable response is, therefore, earnestly requested.

Thank you.

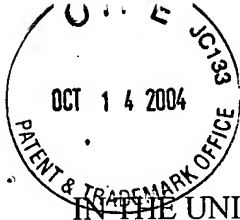
Respectfully submitted,

Dated: 14 October 2004

A handwritten signature in black ink, appearing to read "Kenneth P. Glynn", written over a horizontal line.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

HARRY W. EBERLE III

Serial No.: 10/037,325

Filing Date: January 3, 2002

For: DECKING SYSTEM AND ANCHORING
DEVICE

: Examiner:

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: ERNESTO GARCIA

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: Group Art Unit No. 3679

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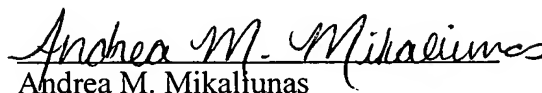
: Attorney Docket No.

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EM RRR No. ER 416519179 US
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